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OFFICE OF PETITIONS
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In re Application of
Carmello, et al
Application No. 09/746,219
Filed: 22 December, 2000
Attorney Docket No. CARP-0087

DECISION GRANTING PETITION

This is a decision on the petition under 11(a) and (c) of 37 C.F.R. §1.55¹ (Rule 55) filed on

¹ The regulations at 37 C.F.R. §1.55 provide:

§ 1.55 Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, and 365(a) and (b).

(1)(i) In an original application filed under 35 U.S.C. 111(a), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time period in this paragraph does not apply to an application for a design patent.

(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.

(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

(3) When the application becomes involved in an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, or when deemed necessary by the examiner, the Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than provided in paragraphs (a)(1) or (a)(2) of this section.

(4) An English language translation of a non-English language foreign application is not required except when the application is involved in an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, or when specifically required by the examiner. If an English language translation is required, it must be filed together with a statement that the translation of the certified copy is accurate.

(b) An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant when submitting a claim for such right as specified in paragraph (a) of this section, shall include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

(c) Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) and (f), or 365(a) not presented within the time period provided by paragraph (a) of this section is considered to have been waived. If a claim for priority under 35 U.S.C. 119(a) through (d) and (f), or 365(a) is presented after the time period provided by paragraph (a) of this section, the claim may be accepted if the claim identifying the prior foreign application by specifying its application

29 May, 2001, and supplemented via FAX on 11 July, 2001, requesting that the above-identified application be accorded a filing date of 30 March, 2001 (rather than 31 March, 2001, as previously accorded).

The petition is **GRANTED in part and is moot in part.**

Rule 55 requires that claims for priority must be made by the later of four (4) months from the filing of the application claiming priority (i.e., the instant application) or sixteen (16) months of the filing of the application(s) from which priority is claimed.

The record indicates that:

- the instant application was filed on 22 December, 2000;
- Petitioner has not heretofore claimed, but wishes to claim, priority from foreign-filed applications as follows:
 - (1) Great Britain, Application No. 9930666.4 (filed 24 December, 1999);
 - (2) Great Britain, Application No. 9930751.4 (filed 29 December, 1999); and
 - (3) Europe, Application No. 00308126.2 (filed 18 September, 2000).

As to item (3), above, the deadline for claiming priority is 18 January, 2002, and therefore the instant claim for priority is timely under the rule, no relief is necessary, and the petition is moot.

As to items (1) and (2), above, Petitioners have satisfied the fee and statement requirements of Rule 55(c)(1) and (2), and the claims are accepted on petition.

The application file is being forwarded to Office of Initial Patent Examination for processing of the additional claims of for priority, as follows:

number, country (or intellectual property authority), and the day, month, and year of its filing was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a) through (d) and (f), or 365(a) must be accompanied by:

- (1) The surcharge set forth in § 1.17(t); and
- (2) A statement that the entire delay between the date the claim was due under paragraph (a)(1) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.
[para. (b), 48 FR 41275, Sept. 17, 1982; 48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; para. (b), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a) revised, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; para. (a), 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; para. (a) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised and para. (c) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a) and (c) corrected, 65 FR 66502, Nov. 6, 2000, effective Nov. 29, 2000]

- (1) Great Britain, Application No. 9930666.4 (filed 24 December, 1999);
- (2) Great Britain, Application No. 9930751.4 (filed 29 December, 1999); and
- (3) Europe, Application No. 00308126.2 (filed 18 September, 2000); and

issuance of a corrected Filing Receipt reflecting those claims. The application file will then be forwarded for processing as necessary.

Telephone inquiries specific to this matter should be directed to John J. Gillon, Jr., Attorney, Office of Petitions, at (703) 305-9199.



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